



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,796	01/16/2002	Yulun Wang	155695-0238	1554

1622 7590 04/25/2003

IRELL & MANELLA LLP  
840 NEWPORT CENTER DRIVE  
SUITE 400  
NEWPORT BEACH, CA 92660

EXAMINER

RAM, JOCELYN DEBRA

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 04/25/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/051,796

Applicant(s)

WANG ET AL.

Examiner

Jocelyn D Ram

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities: page 18, line 4, "surgical 26, 28, 30 or 32." should be changed to -surgical instruments 26, 28, 30 or 32.--; page 18, line 18, "provide feedback" should be changed to -provides feedback--; page 25, line 3, "audatory" should be changed to -auditory--; page 35, line 10, "radian's" should be changed to -radians--. Appropriate correction is required.

### *Claim Objections*

Claims 10 and 20 are objected to because of the following informalities: claims 10 and 20, line 2, "arbritator" should be changed to -arbitrator--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the

application was filed, had possession of the claimed invention. The term "arbitrator" has not been described in the specification and it is not clear what part of the invention this term refers to.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites "a handle" in line 3, however "a handle" is previously recited in line 2. Therefore this claim is indefinite since it is not clear if there are one or two handles being claimed. To clarify that these are two distinct handles, it is suggested that they be referred to as --a first handle-- and --a second handle--.

Claim 21 recites the limitation "the first medical instrument" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is suggested that "instrument" be changed to --device--.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-18, 21-26, 28-31, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima et al. (5,855,553). Tajima shows a medical robotic system, comprising: a first medical device; a first input device (grip 3007 of first operator) that can be moved a first input distance to move said first medical device (102); a second input device (grip 3007 of second operator) that can be moved a second input distance to move said first medical device (102); and a feedback device that provides an indication of a difference between the first and the second input distances by force feedback (Fig. 39) and visual feedback (107), wherein the force feedback is applied to said first and second input devices, said first and second input devices include handles (Figs. 38a, 38b, 38c), a communication interface (103) couples said first and second input devices to said first medical device (102), and said first medical device includes a robotic arm (Fig. 14) coupled to a medical instrument (1401).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 19, 27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima et al. Tajima shows all of the limitations of claims 9, 19, 27 and 32 except for a switch that allows the first input device to assume sole control of said first medical device. However, Tajima does disclose a simulation training function that allows the device to be operated by one person (col 24). Thus, although there is no specific switch disclosed, Tajima does provide for varying the weight of the input of the different surgeons, and it would be obvious to one of ordinary skill in the art at the time of the invention to provide a switch to simplify such a process.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ohtsuki (6,470,236), Bullen (6,292,712), and Tajima et al. (6,402,737) all show robotic surgery devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn D Ram whose telephone number is (703) 308-6392. The examiner can normally be reached on Mon-Fri, 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers

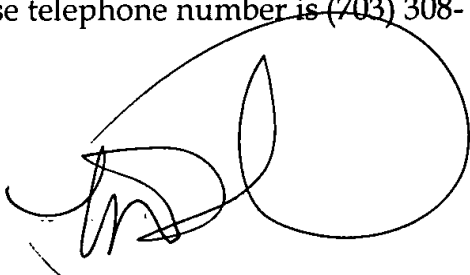
Art Unit: 3739

for the organization where this application or proceeding is assigned are (703) 872-9302

for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JR  
April 15, 2003



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700